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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/643,260 | 08/22/2000 | Michael J. May | PPI-117 | 9021 |
| 959 | 7590 | 06/03/2003 | | |
| LAHIVE & COCKFIELD 28 STATE STREET BOSTON, MA 02109 | | | EXAMINER | MITRA, RITA |
| | | ART UNIT | PAPER NUMBER | |
| | | 1653 | 13 | |
| DATE MAILED: 06/03/2003 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

File Copy

| Office Action Summary | Application No. | Applicant(s) |
|-----------------------|------------------------|------------------|
| | 09/643,260 | MAY ET AL. |
| | Examiner Rita Mitra | Art Unit 1653 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 March 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 22 is/are allowed.
- 6) Claim(s) 19-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other:

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DETAILED ACTION

Status of the Claims

Applicants' amendment and response to office action dated September 24, 2002, filed on March 4, 2003 in paper #11 is acknowledged. Claims 19, 20 and 22 have been amended. New claims 24-27 have been added.

Newly submitted claims 24-27 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 24-27 reads on original claims 15-17 (Group VI), which were restricted from claims 19-22 (Group VII) because they are different products, therefore, inventions are patentably distinct (see Election/Restriction, paper# 7). Claims 19-22 (Group VII) were elected for examination in paper #8.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-27 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Therefore, claims 19-22 currently pending and are under examination.

Response to Remarks and arguments

Rejections under 35 U.S.C. § 112, first paragraph

Rejection of claims 19-22 under 35 U.S.C. 112, first paragraph is withdrawn in view of Applicants' amendment to claims.

Rejections under 35 U.S.C. § 102

Rejection of claims 19-22 under 35 U.S.C. 102, is withdrawn in view of Applicants' amendment to claims.

New grounds of Rejection

Rejections under 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 19-21 are rejected under 35 U.S.C. 102(b) as anticipated by Rothe et al. (WO 99/01541, January 14, 1999). Rothe et al. teach an IKK-alpha protein, which has 100% sequence identity to SEQ ID NO: 2 (see sequence alignment result, Cao et al., A_Geneseq_101002 database, Accession NO: AAW96182, April 27, 1999). This reads on claims 19, 20 and 21, which has an isolated polypeptide comprising an amino acid sequence selected from the group consisting of SEQ ID NO: 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18 and 19 (claim 19). See the sequence alignment attached to the Cao et al. reference. As to claims 20 and 21, the Rothe et al. reference discloses a composition comprising the IKK-alpha polypeptide (page 3, line 1) that would have been the composition that contains the peptide of claim 19.

Claim 19 is rejected under 35 U.S.C. 102(a) as anticipated by Adams et al. (Science, vol 287, pp 2185-2195, March 24, 2000). Adams et al. teach a CG6060 protein from Drosophila melanogaster, which has 100% sequence identity to SEQ ID NO: 9 (see sequence alignment result, Adams et al., SPTREMBL_21 database, Accession NO: Q9VTL8, May 1, 2000). This reads on claims 19, 20 and 21, which has an isolated polypeptide comprising an amino acid sequence selected from the group consisting of SEQ ID NO: 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18 and 19 (claim 19). See the sequence alignment attached to the Adams et al. reference.

Conclusion

Claims 19-21 are rejected. Claim 22 is allowable.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rita Mitra whose telephone number is (703) 605-1211. The Examiner can normally be reached from 9:30 a.m. to 6:30 p.m. on weekdays. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Christopher Low, can be reached at (703) 308-2923. Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center number is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Rita Mitra, Ph.D.

May 26, 2003



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